

Response

Applicant: Norman L. Oberski et al.

Serial No.: 10/622,848

Filed: July 18, 2003

Docket No.: A126.113.102

Title: INSPECTION TOOL WITH A 3D POINT SENSOR TO DEVELOP A FOCUS MAP

REMARKS

The following remarks are made in response to the Final Office Action mailed May 11, 2006. In that Office Action, the Examiner rejected claims 1, 2, 4, 5, 8, and 18 under 35 U.S.C. § 102(e) as being anticipated by McCord et al., U.S. Patent No. 6,597,006 ("McCord"). Claims 6, 10-12, 14-17, 19, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McCord. Claims 3, 9, 13, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McCord in view of Watanabe et al., U.S. Patent No. 6,107,637 ("Watanabe"). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over McCord in view of O'Dell et al., U.S. Patent No. 6,324,298 ("O'Dell").

Claims 1-21 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §§ 102, 103 Rejections

An Affidavit in compliance with 37 C.F.R. § 1.131 accompanies this Response along with Exhibits in support thereof. In particular, the Affidavit of both named inventors of the instant application properly swears behind the potential priority date of McCord. Thus, it is believed that the rejection of claims 1-21 is fully traversed with withdrawal of the rejections, allowance of the claims, and notice to that effect respectfully requested.

Furthermore, it is also believed that the claims are patentably distinct from the cited references. For example, claim 17 is not taught or suggested by the cited references. In particular, claim 17 relates to an inspection system including a 3D point sensor, wherein the 3D point sensor is a confocal point sensor. In rejecting claim 17, the Office Action accedes that McCord does not teach a confocal sensor. Instead, the Office Action forwards a position that one of ordinary skill in the art at the time of the invention would be motivated to use a confocal sensor in the system of McCord "to achieve a high resolution image by eliminating unwanted light that is not in the focal

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plane.” *FOA 05-11-06* at p. 6. As a preliminary matter, the Office Action has not cited any prior art teaching related to confocal sensors to combine with McCord. Thus, the references cited in the rejection do not teach or suggest all of the claim limitations of claim 17 such that a *prima facie* case of obviousness is not established.

Next, one having ordinary skill in the art would not have a reasonable expectation of success and would not otherwise be motivated to perform the proffered modification of McCord. There is no guidance in any of the cited references for combining a confocal point sensor with McCord. In fact, the functionality of McCord would be defeated by incorporating confocal principles. In particular, McCord relates to height determination of a surface of the specimen by angularly reflecting light from a surface and measuring a shift in position of the reflected light beam on a detector. *McCord* at col. 5, ll. 16-27 and 34-40. One having ordinary skill in the art would not view confocal sensors as operating by measuring a shift in position of reflected light. Indeed, if a masking pinhole structure or the like were incorporated with McCord, as is typically used with confocal systems, McCord would no longer be able to measure a shift in position of a laser on a detector, as the laser would interfere with a pinhole structure upon a shift in position and the position signal would be lost. In other words, the principles according to which McCord operates would be defeated, or at the very least teach away from a confocal sensor. Thus, a *prima facie* case of obviousness is not established.

Finally, the Final Office Action fails to cite any authority for the proffered motivation “to achieve a high resolution image by eliminating unwanted light that is not in the focal plane.” For at least such additional reasons, a *prima facie* case of obviousness is not established. See *MPEP* § 2143, “Basic Requirements of a *Prima Facie* Case of Obviousness.”

In view of at least the above, it is believed that claim 17 is not taught or suggested by the cited references. Thus, withdrawal of the rejection of claim 17, allowance of that claim, and notice to that effect are respectfully requested.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-21 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-21 are respectfully requested.

Applicants hereby authorize the Commissioner for Patents to charge Deposit Account No. 50-0471 in the amount of \$790.00 (to cover the fees as set forth under 37 C.F.R. 1.17(e)).

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to Victor P. Jonas at Telephone No. (612) 767-2503, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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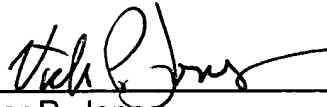
Respectfully submitted,

Norman L. Oberski et al.,

By their attorneys,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10th day of August, 2006.

By: 
Name: Victor P. Jonas